

Appl. Number 10/521,392

(Aflalo et al.)

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**REMARKS****General Overview of Claim Changes**

To address the Office Action rejections, claims 1-18 have been canceled and replaced by new claims 22-38 (claims 19-21 were withdrawn as a result of the election made in Amendment A).

New claims 22-35 correspond to previous claims 1-14; however, the claim language has been changed to overcome the 35 USC 101 and 35 USC 112 rejections of claims 1-14, as will be discussed more fully below.

New claim 36 corresponds to previous claim 15 combined with previous claims 17 and 18, because the subject matter of previous claims 17 and 18 (SIM card and supplemental memory media interfaces) has been moved up into new claim 36. New claim 37 corresponds to previous claim 16.

A new method claim 38 has been added, defining the directional dialing cellular telephone method used by the system and device defined in the other new claims.

**35 USC 101 Rejection of Claims 1-14 & 35 USC 112 Rejection of Claim 1**

Claims 1-4 has been replaced by new claims 22-35, and the language of the new claims addresses the 101 and 112 rejections. Specifically, "protocol" has been replaced by "system", which is clearly statutory subject matter. Claim 22 has also been restructured to remove the protocol steps present in previous claim 1, and instead define the protocol as parts of the system.

While Applicants believe that the claims for a protocol would properly satisfy all of the necessary conditions for the instant invention, we recognize that there are legal and administrative circumstances which would remain more consistent should the instant application use a distinctly statutory machine or process claiming language. Accordingly, Applicants request that the Examiner not construe the new claim language as incorporating any new limitation of subject matter over the protocol claims that they replace.

Applicants also wish to draw the Examiner's attention to the following excerpt from the USPTO guidelines on patent subject matter eligibility, which confirms that an apparatus claim with process steps is a proper claim:

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[USPTO - Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility] "For example, a claimed invention may be a combination of devices that appear to be directed to a machine and one or more steps of the functions performed by the machine. Such instances of mixed attributes, although potentially confusing as to which category of patentable subject matter it belongs in, does not affect the analysis to be performed by the examiner. Note that an apparatus claim with process steps is not classified as a "hybrid" claim; instead, it is simply an apparatus claim including functional limitations. See, e.g., *R.A.C.C. Indus. v. Stun-Tech, Inc.*, 178 F.3d 1309 (Fed. Cir. 1998) (unpublished)."

Applicants request that Examiner evaluate the new claims in the application in light of the above USPTO guideline.

**35 USC 103 Rejection of Claims 1-16 Using Oprescu-Surcobe '130 Modified by Teicher '849 A1 and Heinonen '237 A1; 35 USC 103 Rejection of Claims 17-18 Using Oprescu-Surcobe '130 Modified by Teicher '849 A1, Heinonen '237 A1, and Provost '948 A1.**

Claims 1-18 have been replaced by new claims 22-37, as discussed earlier. The new claims overcome the 103 rejections applied to the previous claims, for the following reasons:

Surcobe deals with an entirely different system than the present application. Surcobe has his mobile device transmitting to the base station firstly via an omni-directional antenna and then via a directional antenna. This sequence helps the mobile unit locate the direction for pointing the directional antenna. The present application begins with the user pointing the mobile directional antenna at a base station omni-directional antenna. Characteristic of this action is the user's visual contact with the base station – otherwise the communications protocol never "gets off the ground".

Simply stated, while the mobile unit of the present invention includes an omni-directional antenna, the protocol of the instant invention begins with the using of the mobile unit's directional antenna, and the handshake then proceeds as the mobile unit receives a first confirmation fragment on its omni-directional antenna. Up to here – this is opposite in order (and opposite in purpose) to Surcobe. Surcobe is solving a problem of how to increase the number or privacy or data rate of cellular units within a base station coverage. The instant application is introducing a new feature for allowing facile transactions by the mobile phone user with targets that are within visual sighting. The base stations of Surcobe are attempting to calculate targeting coordination with the active help of facilities of the base station.

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What seems in common between the instant application and Surcobe, is that both relate to a mobile unit that has both directional and omni-directional antennas. However the entire underlying protocol of use for accomplishing a handshake between these mobile units and their respective base station units are mutually exclusive. There is no commonality between the operational functional limitations of the instant invention and Surcobe. Essentially, it is for these reasons that Surcobe must teach many aspects of antenna theory calculation to achieve some measure of enablement, while the instant application relies on operational aspects that are already familiar to the man of the art.

It seems accepted doctrine that claims are a decomposition of an invention into components and their respective attachments – wherein all of said components and respective attachments are known to the ordinary man of the art. If this were not the case, then the invention would include an aspect that the inventor is unwilling to disclose or that has not been invented yet.

Thus, in the case of the instant invention application, Applicants consider it to be utterly reasonable that the Office Action cites prior art that includes substantially every component and substantially every aspect of respective attachment there between. However, we find no indication in this, or any other prior art, that indicates that an ordinary man of the art would have known to make such a combination. Certainly, we see no indication in the prior art cited by the examiner of any awareness of the need for a pointing initiation of a communications link.

The narrow prior art suggests that there is some level of awareness of the field of the invention. The broad prior art certainly discloses universes of electronic components, electronic systems, and imbedded software therein. Nevertheless, the ordinary man of the art has no rational motivation to enable all possible combinations of the respective elements of these universes of components, systems, and software.

Essentially, to believe the “obviousness” of the instant combination, one would at least also like to see that someone would have found a need for and a means to combine Teicher with Heinenon – within the same broad field of invention as Surcobe. Otherwise, one should conclude that the instant application has properly disclosed embodiments of a valid inventive combination; that overcomes many of the shortsighted failings and cumbersome limitation of Surcobe – even if one would dream that Surcobe thought about reversing the operations steps in the protocol that he discloses. More particularly, one would want to see Surcobe direct his apparatus to the handshake of the instant invention. Otherwise, one might reasonably conclude that the instant invention has seen a new use for some of the components found in Surcobe.

Simply stated, Applicants find it untenable to believe that the prior art demonstrates any rational reason to combine (Surcobe) a directional antenna, an omni-directional antenna, (Teicher) bluetooth, and (Heinenon) a mutual common service provider into any single enabling

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embodiment. Indeed, none of these references are aware or concerned with the usefulness of the instant application. In the absence of such a rational reason, it is difficult to comprehend the Office Action's conjecture regarding the "obviousness" of the instant invention. The difficulty is further complicated by the Office Action's suggestion that the ordinary man of the art would further combine Provost with Surcobe, Teicher, and Heinenon.

Furthermore, the Office Action situates the obviousness into a hypothetical art, wherein the ordinary practitioner is sorely tried to succeed in combining any two of these four aforementioned elements. Clearly, the most obvious case of two-element combination is Surcobe; but beyond that, there seems to be a great gap between the ordinary man of the art and those insightful experts capable of instructing us as to the viability of such a four-element combination.

In addition, Surcobe neither really suggest a similarity of circumstance nor of essential features in common with the instant invention application. Surcobe actually relates to a problem having three active wireless stations (one fixed and two mobile). Frankly, it is even unclear if Surcobe would appreciate how to independently accomplish the instant application invention.

#### **The Use of Heinonen '237 A1 as a Prior Art Reference.**

Applicants would also like to raise the following issues concerning the use of Heinonen '237 A1 as a prior art reference:

Heinonen was filed on August 31, 2005 and published on December 22, 2005. Both of these dates are after Applicants' filing date of January 15, 2005 and Applicants' priority date of July 16, 2002.

The cover sheet of the Heinonen publication indicates that this application is a continuation of U.S. Appl. No. 10/083,143, filed on February 27, 2002, and Applicants assume that this is why Heinonen was cited as prior art. However, in such cases the Examiner must evaluate whether the prior application supports the subject matter used to make the rejection, as set forth in MPEP 706.02(f)(1)(B):

*"The 35 U.S.C. 102(e) date of a reference that did not result from, nor claimed the benefit of, an international application is its earliest effective U.S. filing date, taking into consideration any proper benefit claims to prior U.S. applications under 35 U.S.C. 119(e) or 120 if the prior application(s) properly supports the subject matter used to make the rejection in compliance with 35 U.S.C. 112, first paragraph."*

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Applicants request that Examiner demonstrate that the subject matter used in Heinonen to reject the present application is properly supported in U.S. Appl. No. 10/083,143. Applicants note that this application was withdrawn before issue, and was either not published or the publication was withdrawn when the application was withdrawn.

Whatever the case, Applicants cannot access U.S. Appl. No. 10/083,143 in order to themselves assess whether the application properly supports the subject matter used in Heinonen to reject the present application. Applicants therefore request that the Examiner provide them with the application, if Heinonen is used as a prior art reference in a future Office Action.

Further, and more importantly, Heinonen's specification does not contain a specific reference to U.S. Appl. No. 10/083,143, and thus is not entitled to the benefit of that earlier application under 35 USC 120:

"35 USC 120 Benefit of earlier filing date in the United States.

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application *and if it contains or is amended to contain a specific reference to the earlier filed application.*"

The mere citation of the earlier application on the publication cover page is not sufficient to satisfy 35 USC 120. Instead, the first line of Heinonen's specification must state that it is a continuation of the earlier-filed application – and it does not. See also 37 CFR 1.78 (a)(2).

In sum, because Heinonen does not get the benefit of the earlier-filed application, it is not available as a prior art reference against the present invention.

## CONCLUSION

For all of the above reasons, Applicants submit that the new claims define patentably over the prior art. Applicants submit that this application is now in condition for allowance, which action they respectfully solicit.

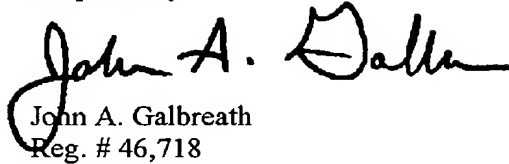
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Respectfully,



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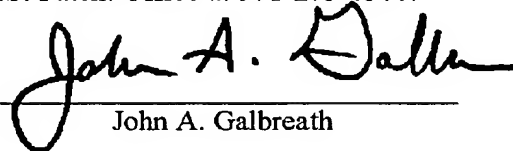
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12 April 2006

  
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John A. Galbreath